

REMARKS

Applicant respectfully requests allowance of the subject application in view of the following remarks and the accompanying Declarations.

Claims 1-12 are pending in the application, with claim 1 being independent.

Statement of Substance of Interview

Initially, Applicant wishes to thank the Examiner for conducting interviews with Applicant's Attorney, David A. Divine, on June 12, June 13, and June 28, 2006.

During the interviews, Applicant's Attorney presented arguments in support of the sufficiency of the Declaration under 37 C.F.R. § 1.131 (the "original 131 Declaration") accompanying the January 20, 2006 Response to the previous Office Action. Applicant's Attorney understood the Examiner to agree that the original 131 Declaration was sufficient to establish conception, but that the original 131 Declaration was ineffective to establish an actual reduction practice prior to the effective date of Tsumagari et al. Specifically, the Examiner was of the opinion that while the original 131 Declaration established that the claimed features were present in the Beta 2 release of Windows® Millennium on or about November 24, 1999, this did not show actual reduction to practice because there was no showing that the claimed features were working as of the Beta 2 release.

Without conceding the propriety of the rejection and in the interest of expediting prosecution, Applicant's Attorney proposed to file a Supplemental 131 Declaration providing additional evidence showing that the Beta 2 release of Windows® Millennium operating system performed the features presently claimed in the subject application. In

1 further support of the facts laid out in the Supplemental 131 Declaration, Applicant's
2 Attorney also proposed to file a declaration of a corroborating witness, Theodore
3 Youmans, who is not an inventor of the subject application.

4 The Examiner tentatively agreed that such a Supplemental 131 Declaration, along
5 with a corroborating declaration by someone other than the inventors, would be sufficient
6 to establish actual reduction to practice. However, the Examiner asked that the
7 arguments and legal basis for the declarations be presented in writing. Accordingly,
8 Applicant submits herewith a Supplemental 131 Declaration, along with a corroborating
9 Declaration of Theodore Youmans, a Software Test Lead for Applicant. Applicant
10 submits that the foregoing information is sufficient to establish conception and actual
11 reduction to practice at least as early as November 24, 1999.

12 **Art Rejections**

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14 In the Office Action, Claims 1-12 remain rejected under 35 U.S.C. § 103 as being
15 obvious over U.S. Patent No. 6,798,976 B1 (Tsumagari et al.) in view of U.S. Patent No.
16 6,525,746 B1 (Lau et al.). This rejection is respectfully traversed.

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18 In Applicant's January 20, 2006 Response to the previous Office Action,
19 Applicant filed the original 131 Declaration, establishing conception and reduction to
20 practice of the claimed subject matter at least as early as November 24, 1999, over five
21 months prior to the earliest U.S. filing date of Tsumagari et al. Accordingly, Tsumagari
22 et al. does not qualify as prior art against the subject application.

23 The outstanding Office Action rejected the original 131 Declaration, stating that
24 "the declaration filed on 1/20/06 under 37 CFR 1.131 has been considered but is
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1 ineffective to overcome the reference,” because “there is no provided evidence, but,
2 merely a statement with respect to reduction to practice” The Office Action goes on
3 to state that “actual reduction to practice of the claimed, invention, requires that the
4 invention, must have been sufficiently tested to demonstrate that it will work for its
5 intended purpose, there exist no evidence with respect to demonstrating that the claimed
6 invention was working as of the Beta releases 2, 2.5, or 3.” (Emphasis omitted.)
7 Applicant respectfully disagrees that the original 131 Declaration was ineffective.
8 Nevertheless, without conceding the propriety of the rejection, and in the interest of
9 expediting prosecution, Applicant submits herewith a Supplemental Declaration under 37
10 C.F.R. § 1.131 (the “Supplemental 131 Declaration”), along with a corroborating
11 Declaration of Theodore Youmans.

12 The Supplemental 131 Declaration includes further allegations of fact and
13 evidence supporting an actual reduction to practice at least as early as the Beta 2 release
14 of Windows® Millennium operating system. The Court of the Appeals for the Federal
15 Circuit (“Federal Circuit”) has held that an applicant may prove actual reduction to
16 practice by “establish[ing] three things: ‘(1) construction of an embodiment or
17 performance of a process that met all the limitations of the interference count; (2) . . .
18 determination that the invention would work for its intended purpose,’ Cooper, 154 F.3d
19 at 1327; and (3) the existence of sufficient evidence to corroborate inventor testimony
20 regarding these events.” Medichem, S.A. v. Rolabo, S.L., 437 F.3d 1157 (Fed. Cir.
21 2006); see also Cooper v. Goldfarb, 154 F.3d 1321, 1330 (Fed. Cir. 1998) (“In order to
22 establish an actual reduction to practice, an inventor’s testimony must be corroborated by
23 independent evidence.”). “Independent corroboration may consist of testimony of a
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1 witness, other than the inventor, to the actual reduction to practice or it may consist of
2 evidence of surrounding facts and circumstances independent of information received
3 from the inventor.” Medichem, 437 F.3d at 1171. In both Medichem and Goldfarb, the
4 court considered testimony of non-inventors employed by the same company as the
5 inventor(s) to corroborate the inventors’ testimony regarding reduction to practice. For
6 example, in Goldfarb, the court found that corroborating testimony of the inventor’s
7 assistant, Moore, supported the inventor’s actual reduction to practice. In this case, all
8 three of the requirements for showing actual reduction to practice have been met.

9 First, an embodiment was constructed that met the limitations of the pending
10 claims (i.e., the DVD navigator present in the Beta 2 release of Windows® Millennium
11 operating system), as evidenced by the statement on page 1 of the Invention Disclosure
12 Document, a copy of which is attached to the Supplemental 131 Declaration as Exhibit A.
13 Indeed, the Office Action does not question that the features claimed in the subject
14 application were present in the Beta 2 release of Windows® Millennium, stating only that
15 it lacks evidence that the Beta 2 release was sufficiently tested to demonstrate that it
16 functioned for its intended purpose.
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18 Second, the inventors and others determined that the claimed features would work
19 for their intended purpose. The MPEP explains that “[f]or actual reduction to practice,
20 the invention must have been sufficiently tested to demonstrate that it will work for its
21 intended purpose, but it need not be in a commercially satisfactory stage of
22 development.” See MPEP 2138.05, Requirements to Establish Actual Reduction to
23 Practice. In this case, the inventors and others determined that the invention would work
24 for its intended purpose at least when they tested the DVD navigator of the Beta 2 release
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1 of Windows® Millennium prior to releasing it to beta testers. During this testing, the
2 DVD navigator of the Beta 2 release of Windows® Millennium was found to function
3 properly, as discussed in numbered paragraphs 6-8 of the Supplemental 131 Declaration
4 and paragraphs 3 and 4 of the Declaration of Theodore Youmans.

5 Third, the inventors' testimony regarding reduction to practice is corroborated by
6 declaration testimony of a non-inventor. Specifically, the Declaration of Theodore
7 Youmans states in numbered paragraphs 3 and 4 that he tested the DVD navigator
8 incorporated in the Beta 2 release of Windows® Millennium operating system before it
9 was released to beta testers, and that it functioned properly.

10 In addition, the surrounding facts and circumstances support the actual reduction
11 to practice. For example, Theodore Youmans located and tested an archived copy of the
12 binary code of the DVD navigator that was incorporated into the Beta 2 release of
13 Windows® Millennium ("the Beta 2 binary"). The results of that test indicated that the
14 Beta 2 binary properly performed its intended purpose, as described in numbered
15 paragraphs 7-15 of the Declaration of Ted Youmans. Additional evidence supporting the
16 actual reduction to practice as of the Beta 2 release of Windows® Millennium includes an
17 article written by one of the beta testers, which states that "[t]he best thing about
18 Millennium, of course, is that *it just works*. Even in this early beta form, it looks like a
19 winner." A copy of that article is attached to the Supplemental 131 Declaration as
20 Exhibit E.
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22 Thus, the Supplemental 131 Declaration includes sufficient allegations of fact and
23 supporting exhibits to establish that the features claimed in the subject application were
24 working properly as of the Beta 2 release of Windows® Millennium. Accordingly,
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1 Applicant is entitled to conception and reduction to practice dates of the claimed subject
2 matter, at least as early as November 24, 1999, thereby obviating the rejections based on
3 Tsumagari et al.

4 Lau et al. was cited for its alleged teaching of "APIs with respect to plug-ins to
5 facilitate book-marking, handling commands and returning event meta data or attributes
6 and/or other functions associated with the navigator programming" (Office Action, page
7 8, first full paragraph). However, Lau et al. lacks numerous salient features of the
8 independent claims.

9 For at least the foregoing reasons, claims 1-12 are believed to be allowable over
10 the cited documents.

11
12 **CONCLUSION**

13 Applicant requests reconsideration and withdrawal of the § 103 rejections, and an
14 early notice of allowance.

15 If any issue remains unresolved that would prevent allowance of this case, **the**
16 **Examiner is requested to contact the undersigned attorney to resolve the issue.**

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18 Respectfully submitted,

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20 Date: July 31, 2006

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